THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN M. FRIEL

Appeal No. 95-3425
Application 08/000,527[1]

ON BRIEF

Before KIMLIN, JOHN D. SMITH and OWENS, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 11-19, all the claims remaining in the present application. Claim 11 is illustrative:

11. A method for eliminating the need for volatile organic solvent coalescents in aqueous emulsion polymer-containing paint compositions comprising forming an aqueous emulsion polymer-containing paint composition containing no volatile organic solvent coalescent by the addition to an aqueous composition a

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[1] Application for patent filed January 8, 1993. According to appellant, this application is a continuation of Application 07/548,035, filed July 5, 1990, now abandoned.

polymeric blend of at least one hard emulsion polymer having a glass transition temperature greater than about 20 degrees Centigrade and at least one soft emulsion polymer having a glass transition temperature less than about 15 degrees Centigrade, where the polymeric blend contains from about 20 to about 60 weight percent of the hard emulsion polymer and from about 80 to about 40 weight percent of the soft emulsion polymer.

In the rejection of the appealed claims, the examiner relies upon the following reference:

Padget et al. (Padget) 4,783,498 Nov. 8, 1988

Appellant's claimed invention is directed to a method of forming an aqueous emulsion polymer-containing paint composition which contains no volatile organic solvent. The method entails adding to an aqueous composition a polymeric blend of at least one hard emulsion polymer and at least one soft emulsion polymer. The hard emulsion polymer has a glass transition temperature greater than about 20EC, while the soft emulsion polymer has a glass transition temperature less than about 15EC. The organic solvent, which is eliminated by the present invention, has the disadvantages of an unpleasant odor as well as adverse environmental and health effects. We are told that in addition to avoiding the disadvantages of an organic solvent, the paint composition produced by the claimed method exhibits excellent coating properties, such as hardness and block resistance.

Appealed claims 11-19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103 as being unpatentable over Padget.

Upon careful consideration of the opposing arguments presented on appeal, we will not sustain the examiner's rejections.

We consider first the rejection of the appealed claims under § 102. It is fundamental that to support a rejection under 35 U.S.C. § 102 a single prior art reference must describe every claim limitation. In the present case, independent claim 11, upon which claims 12-18 ultimately depend, recites the positive method step of "forming an aqueous emulsion polymer-containing paint composition" (emphasis added). In order to qualify as a paint according to one of ordinary skill in the art, a composition must have certain characteristics. On the other hand, Padget, the single reference applied by the examiner, does not describe forming a paint composition. Rather, Padget discloses aqueous latex copolymer compositions which are suitable for use as contact adhesives, which "is a substance which when coated on two substrates to be bonded enables a strong bond to be formed between the substrates on and after initial contact at ambient temperature without the requirement of any sustained pressure setting time" (column 1, lines 5-12). Consequently,

although Padget discloses a composition which comprises the presently claimed hard emulsion polymer and soft emulsion polymer, the reference composition, owing to all its components, is a contact adhesive, not a paint.

The examiner's rationale that "[t]he term paint relates to a future intended use of the composition made from the instantly claimed method" (page 3 of Answer) is not well taken. The claimed term "paint" defines a composition that is understood by one of ordinary skill in the art to possess certain, essential characteristics and properties, one of which is not to bond two substrates, as the contact adhesive of Padget.

Regarding the rejection of the appealed claims under § 103, the examiner has not supplied any explanation why one of ordinary skill in the art would have been motivated to modify the contact adhesive composition of Padget in such a way as to produce a paint composition, and none is apparent to us. Manifestly, Padget fails to provide any teaching or suggestion of modifying the disclosed contact adhesive into a paint.

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims is reversed.

REVERSED

EDWARD C. KIMLIN)

Administrative Patent Judge	)	
	)	
	)	
	)	
JOHN D. SMITH	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
TERRY J. OWENS	)	
Administrative Patent Judge	)	

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